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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,206	04/21/2004	Che-Kuei Mai	1176/202	9032
26588 LIU & LIU 444 S. FLOWER STREET SUITE 1750 LOS ANGELES, CA 90071	7590 07/01/2008		EXAMINER NGUYEN, JIMMY H	
			ART UNIT 2629	PAPER NUMBER
			MAIL DATE 07/01/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/830,206

**Applicant(s)**

MAI, CHE-KUEI

**Examiner**

JIMMY H. NGUYEN

**Art Unit**

2629

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/27/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.7-13, 16-20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.7-13, 16-20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is made in response to applicant's amendment-after-final filed on 02/27/2008 and entered. Claims 1, 7-13, 16-20, 22 and 23 are currently pending in the application. An action follows below:
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action made by the former examiner, Jean Lesperance, and dated 12/27/2007 is persuasive and, therefore, the finality of that action is withdrawn.

#### *Claim Objections*

3. Claim 8 is objected to because of the following informalities: -- respectively -- should be inserted immediately before "**formed**" in line 2, in order to clarify the claimed invention. Appropriate correction is required.
4. Claim 20 is objected to because of the following informalities: -- the first conductive surface -- should be inserted immediately after "**as**" in line 6 and -- the second conductive surface -- should be inserted immediately after "**as**" in last line, in order to clarify the claimed invention. Further, see claim 7 as a reference. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:  

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 17 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claim 17, this claim contains the limitation, “wherein the display element is at least one of liquid crystal display element, plasma display element and cathode ray tube element.” Note that the above underlined limitation may imply at least **the display element being liquid crystal display element, plasma display element and cathode ray tube element**, while figure 6 and the specification, page 10, lines 22-26, disclose a display system comprising a **single** display element coupled with a touch panel. In other words, the disclosure was not fairly described in the specification or drawings a display system comprising all three display elements, a liquid crystal display element, plasma display element **and** cathode ray tube element, and a touch panel operatively coupled to **all three** display elements as implied by the above underlined limitation, in such a way as to enable one skilled in the art to recognize why the display system of this claim may require three distinct elements, as presently claimed.

As per claim 19, this claim contains the limitation, “[T]he electronic device ... comprising at least one of a portable device, a display monitor and a user input device.” Note that the above underlined limitation may imply **the electronic device comprising all three separate devices**, a portable device, a display monitor and a user input device, which was not fairly described in the specification, in such a way as to enable one skilled in the art to recognize why the electronic device of this claim may require three separate devices, as presently claimed.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims **1, 7-13, 16-20, 22 and 23** are rejected under 35 U.S.C. 102(b) as being anticipated by Okahashi (US 6,473,074 B1).

As to **claim 1**, Okahashi discloses a touch panel input device (a coordinate input device 10; see Fig. 1A or 2; col. 4, line 48) comprising:

a contact sensitive panel (Figs. 1A, 2) comprising a first substrate (a sheet-like detecting member 22; Fig. 2; col. 4, lines 56-57) and a second substrate (a sheet-like detecting member 16; Fig. 2; col. 4, lines 34-35) insulated from the first substrate (Fig. 2), wherein the first substrate (22) has a first conductive surface (a resistant film 20; Fig. 2; col. 4, line 58) and the second substrate (16) has a second conductive surface (a resistant film 14; Fig. 2; col. 4, line 55) facing the first conductive surface (20) (Fig. 2), and wherein the first conductive surface and the second conductive surface define an active area (Figs. 1A and 2; col. 6, line 66 through col. 7, line 11);

sensing lines (electrodes 28, 34; Fig. 1A) at the periphery of the active area, which facilitates sensing relative changes in electrical properties arising from user contact within the active area (col. 5, lines 16-44); and

a grounding conductor (ground conductor element 38; Fig. 1A; col. 5, line 46) conductively coupled to the contact sensitive panel outside the active area (Figs. 1A and 2), and configured to be conductively insulated from the sensing lines (28, 34) and the first and second conductive surfaces (20, 14) and conductively coupled to an external ground (a frame ground) (see col. 6, lines 32-36),

wherein the grounding conductor (38) comprises a first section (a section of ground conductor element 38 around the resistant film 14; Figs. 1A, 2) attached to the contact sensitive panel (Fig. 1A, 2), and a second section (distal ends 38a; Fig. 1A) extending from the first section to the external ground (Fig. 1A; col. 6, lines 32-36), wherein the first substrate (22) is exposed to contact by a user (col. 6, line 66 through col. 7, line 11), and wherein the grounding conductor (38) is conductively coupled to the first substrate (22) and the second substrate (16) (Fig. 2).

Accordingly, all elements of this claim are read in the Okahashi reference.

As to **claim 7**, Okahashi discloses the grounding conductor (38) comprising a first conductive layer (an upper layer of the ground conducting element 38; Fig. 2) on the first substrate (22) on the same side as the first conductive surface (209), a second conductive layer (a lower layer of the ground conducting element 38) on the second substrate (16) on the same side as the second conductive surface (14), wherein the first and second conductive layers are conductively coupled (Fig. 2). Note that the ground conducting member 38 considerably comprises three integrated layers, an upper layer, a middle layer, and a lower layer (Fig. 2).

As to **claim 8**, Okahashi discloses the first conductive layer (an upper layer of the ground conducting member 38) and the second conductive layer (a lower layer of the ground conducting member 38) respectively formed on the first and second substrates (22, 16) along with the first and second conductive surfaces (20, 14) on the first and second substrates (22, 16) (Fig. 2).

As to **claims 9 and 11**, Okahashi discloses the grounding conductor (38) comprising a generally loop shaped structure (Fig. 1A).

As to **claims 10 and 13**, Okahashi discloses the loop extending along the periphery of the contact sensitive panel (Fig. 1A).

As to **claim 12**, Okahashi discloses the generally loop shaped structure being a complete closed loop (Fig. 1A).

As to **claim 16**, Okahashi discloses a display system comprising a touch panel and a display element operatively coupled to the touch panel, wherein locations on an active area of the contact sensitive panel correspond to locations on a display area of the display element (col. 11, lines 28-31). Further, see col. 1, lines 12-23.

As to **claim 17**, Okahashi discloses the display element being a LCD or a CRT (col. 11, lines 28-31).

As to **claims 18 and 19**, Okahashi discloses that a touch sensitive input device can be incorporated in the display such as a LCD or CRT (col. 11, lines 28-31) included in a personal computer, a word processor, or an electronic notebook (i.e., the claimed electronic device) (col. 1, lines 12-23). Further note that a personal computer or notebook computer inherently comprises a device controller coupled to the display system and configured to process data corresponding to an image to be tendered by the display system.

As to **claim 20**, since all limitations of this claim are recited in claim 7, this claim is therefore rejected for the same reason set forth in claim 7 above.

As to **claims 22 and 23**, Okahashi discloses that the first conductive film (a resistance film 20) defines the first conductive surface (Fig. 2; col. 4, line 58) and a second conductive film (a resistant film 14) defines the second conductive surface (Fig. 2; col. 4, line 55).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kikuchi (US 5,506,375) discloses a related touch panel input device (Fig. 2) comprising a contact sensitive panel, sensing lines (X,Y sensor lines) and a grounding conductor (solid patch ground 18 or a mesh ground 17; Fig.2) for blocking propagation of noise produced by the circuit board (see Abstract).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675. The examiner can normally be reached on Monday - Friday, 6:30 a.m. - 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jimmy H Nguyen/

Primary Examiner, Art Unit 2629